

REMARKS

Claims 1-18 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Further, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references. Reconsideration of this application is respectfully requested.

35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Rogerson (U.S. Patent Application Publication No. US 2003/0093798, hereinafter Rogerson) in view of Muller et al (U.S. Patent No. 6,389,468, hereinafter Muller et al.). Claims 1-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Rogerson in view of Macera et al (U.S. Patent No. 5,490,252, hereinafter Macera et al.). Applicants' respectfully traverse the rejection and request reconsideration. It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2143). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

TRAVERSE (i): There is no motivation or suggestion contained in the cited art to combine the teachings of the references.

Before obviousness may be established, the Office Action *must show specifically* the principle, known to one of ordinary skill that suggests the claimed combination. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner *must explain* the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. *Id.* The factual question of motivation is material to patentability and *cannot be resolved based on subjective belief and unknown authority*. *Id.* at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce

BEST AVAILABLE COPY

the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. Fromson v. Advance Offset Plate, 755 F.2d 1549, 1556 (Fed. Cir. 1985). *The Office Action fails to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.* Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention.

TRAVERSE (ii): The combination does not provide Applicants' claimed invention.

Applicants' independent claim 1 calls for, among other things, an active network, a vehicle including the active network, a first device and a second device communicatively coupled by the active network, and a data packet, wherein the data packet has an active portion.

Rogerson teaches an in-flight passenger entertainment system that utilizes a distributed network server architecture. The system taught by Rogerson uses a signal bus (18) and a communication management unit (20) to provide content signals onto the bus to be picked up by a plurality of display units (12) (abstract; page 4, paragraphs 0047 to 0049). As Figures 1-6 clearly show, the entertainment system taught by Rogerson requires a bus and a central management unit to operate. Even the wireless network disclosed by Rogerson requires that one of the network machines be elected as a base station (master) of the network with the other network machines functioning as slaves (page 11, paragraph 012). Applicants' wish to respectfully point out that a distributed network and/or a wireless LAN are not, by themselves an active network. Even though the individual nodes in Rogerson might function as both a server and a client, they still must communicate over the bus and have a central management unit or "master," and therefore are not an active network.

Muller et al. discloses a system and method for distributing the processing of network traffic through a protocol stack on a host computer system (abstract). Muller et al. further discloses a network interface circuit (NIC) is configured to receive and process communication packets exchanged between a host computer system and the Internet. The NIC is configured to

receive and manipulate packets formatted in accordance with a protocol stack supported by a network coupled to the NIC (column 6, lines 34-42).

Mancera et al. discloses a system for exchanging packets between networks (abstract). Mancera et al. further discloses converting each received native packet to a packet having a generic format common to all networks connected to the system (column 2, lines 4-6).

An active network is fundamentally different from the network disclosed by Rogerson, Muller et al. or Mancera et al. As is known in the art, an active network is a network that does not use a bus-type architecture or a central computing resource (i.e. a network utility or arbiter as described on page 6, lines 4-6 of the Applicant's specification). Active elements within an active network enable multiple simultaneous communication paths between devices within the network/vehicle (page 7, lines 6-7 of Applicant's specification). An active network is a network in which the nodes are programmed to perform custom operations on the messages that pass through the node. An active network does not require or use a central server or computing resource, as each node in the active network passes "smart packets" that use a self-describing language that allows information carried within a packet to be operated on by a node in the active network.

In the 08/05/03 office action, the Examiner agrees with Applicants that neither Muller et al. nor Mancera et al. teach a vehicle with an active network or first and second devices communicatively coupled by the active network. As stated in the Applicants' previous responses to office actions, neither Muller et al., nor Mancera et al. teach or suggest a vehicle or an active network. As shown above, Rogerson also does not teach or suggest a vehicle with an active network. Since none of the above references teaches or discloses an active network, none of the above references can possibly teach or disclose a data packet having an active portion.

"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). MPEP § 2131. Contrary to Examiner's statement that all elements are disclosed in the above cited references, applicants claimed elements including: *an active network, a vehicle including the active network, a first device and a second device communicatively coupled by the active network, and a data packet, wherein the data packet has an active portion* are not found in any of the above references, so the rejection is unsupported by the art and should be withdrawn.

TRAVERSE (iii): Allegations that portions of Applicant's claims "would have been obvious" are not a proper test for obviousness under 35 U.S.C. § 103(a).

The rejections contained in the Office Action include statements to the effect that elements missing from the combinations provided from the cited references are supplied under the reasoning that these limitations "would have been obvious to one of ordinary skill in the art" or that combining various elements "would have been obvious to one of ordinary skill in the art". These statements are unsupported assertions expressing *conclusions* and as such are *not* reasons for rejection under 35 U.S.C. § 103(a).

Moreover, the test for obviousness must come from, or at least be compatible with, the requirements of 35 U.S.C. § 103(a), stating that: "... if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious ..." (emphasis added; 35 U.S.C. § 103(a)). The Office Action's unsupported assertions at most address obviousness of a *difference* between the claimed subject matter and the prior art, and not obviousness of the *claimed subject matter as a whole*, as required by the plain language of 35 U.S.C. § 103(a).

It is respectfully pointed out that the limitation of an active network, a vehicle including the active network, a first device and a second device communicatively coupled by the active network, and a data packet, wherein the data packet has an active portion is not found in the cited art and that functional claim language must be considered in evaluating a claim relative to the prior art. Lewmar Marine, Inc. v. Barent, Inc., 827 F.2d 744 (Fed. Cir. 1987); Raytheon Co. v. Roper Corp., 724 F.2d 951 (Fed. Cir. 1983). The PTO is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claim limitations are similar to that otherwise found in the prior art. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643 (Fed. Cir. 1987); Fromson v. Advanced Offset Plate, 755 F.2d 1549 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468 (Fed. Cir. 1984); Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782 (Fed. Cir. 1983).

The last sentence of 35 U.S.C. § 103(a) states that "Patentability shall not be negated by the manner in which the invention was made." Accordingly, matter of obvious design choice or within purview of ordinary skill in the art (i.e., "obvious to try") is not a proper standard for rejection of claims under 35 U.S.C. § 103(a).

The rejection in question can only be based upon a hindsight reconstruction enlightened by Applicants' own disclosure. As the CAFC stated in W.L. Gore Associates, Inc. v. Garlock, Inc. (220 USPQ 303, 312-13 (Fed. Cir. 1983)):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, where no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Applicants believe that this rejection has been overcome.

Claims 2-18 depend either directly or indirectly from claim 1 and are believed to be allowable over the relied on references for at least the same reasons as claim 1.

Prior Art Not Relied Upon

The references cited but not relied upon are not believed to anticipate or make obvious applicants' invention.

Summary

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

DOCKET NO.: IA00012

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department

Customer Number: 23330

By: Kevin D. Wills

Kevin D. Wills
Attorney of Record
Reg. No.: 43,993
Telephone: 602-952-4364
Fax No.: 602-952-4376

BEST AVAILABLE COPY